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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,490	04/06/2001	Elizabeth S. Stuart	08952-008001 / UMA 00-19	5744
26161	7590	04/28/2004	EXAMINER FORD, VANESSA L.	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ART UNIT 1645	PAPER NUMBER

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/827,490

Applicant(s)

STUART ET AL.

Examiner

Vanessa L. Ford

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 20 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see Advisory attachment.

3. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, first paragraph.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 7-10, 15, 18 and 19.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☒ Other: Interview Summary and Advisory Attachment.

***Advisory Action Attachment***

1. Applicants amendment, response, Declaration filed under 37 C.F.R. 1.132 and Biological Deposit receipt filed November 20, 2003 is acknowledged.

2. Applicants amendment is not entered because the claim 7 as amended, (claims that depend from claim 7 (i.e. 8-10 and 19)) and claim 18 would require further consideration and require new searches. As amended the claims are directed to a composition comprising a carrier group covalently coupled to an isolated chlamydial oligosaccharide. The claim limitations as amended have not been recited, search or considered before the submission of the After Final Amendment. As to claim 15, the Declaration filed under 37 C.F.R. 1.132 will be considered since there are no new claim limitations are recited in this claim.

3. The Applicant's arguments regarding the rejection of claim 15 under 35 U.S.C. 102(b) as anticipated by Stuart et al were addressed on pages 2-3, paragraph 3 of the Final Office Action. Applicant submitted the Declaration filed under 37 C.F.R. 1.132 to show a side-by-side comparison of the claimed composition and that of the prior art. Applicant urges that the claimed compositions contains fewer contaminants than the composition of the prior art. Applicant urges that the protocol results used to obtained the GLXA composition is significantly better defined than those obtained using the previous protocol. Applicant urges that Figure 3 is a Western blot of the silver stained gel in Figure

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2 which merely confirms that the two bands in the gel at about 32 and 62 KDA which are GLXA.

Applicant's arguments filed November 20, 2003 have been fully considered but they are not persuasive. It is the Examiner's position that the Declaration filed under 37 C.F.R. 1.132 is not sufficient to overcome the rejection. Applicant's declaration discloses Figure 1 which is the gel from the prior art reference and Figures 2 and 3 which are the gels of the claimed composition. The claimed composition as well as the composition of the prior art contain 32 and 62 KDA bands which are GLXA. Regarding Applicant's assertion that "the protocol results used to obtained the GLXA composition is significantly better defined than those obtained using the previous protocol", is referring to the method by which the compositions were obtained. It should be remembered that the claims are directed to compositions (a product) and the purification or production of a product by a particular process does not impart novelty or unobviousness to a product when the same product is taught by the prior art. This particularly true when the properties of the product are not changed by the process in an unexpected manner. See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi, 218 USPQ 289, 29222-292 (CAFC 1983); In re Brown, 173 USPO 685 (CCPA 1972). It should also be noted that claim 15 recites open "claim language" which means that other components besides the GLXA can be present in the composition. Therefore, the rejection is maintained.

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4. The Applicant's arguments regarding the rejection of claim 7-9 and 18 under 35 U.S.C. 102(b) as anticipated by MacDonald et al were addressed on pages 3-5, paragraph 4 of the Final Office Action. Applicant's arguments are directed to the newly amended claims, which have not been entered.

5. The Applicant's arguments regarding the rejection of claims 7-10 and 18-19 under 35 U.S.C. 103(a) as unpatentable over MacDonald et al and Smith et al were addressed on pages 5-7, paragraph 5 of the Final Office action.

Applicant's arguments are directed to the newly amended claims, which have not been entered.

6. The Applicant's arguments regarding the rejection of claim 18 under 35 U.S.C. 112, first paragraph is withdrawn in view of the Deposit information filed November 20, 2003.

#### **Status of Claims**

7. No claims are allowed.


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### **Conclusion**

8. Any inquiry of the general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Office Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for the Group 1600 is (703) 872-9306.

Any inquiry concerning this communication from the examiner should be directed to Vanessa L. Ford, whose telephone number is (571) 272-0857. The examiner can normally be reached on Monday – Friday from 9:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (571) 272-0864.

  
Vanessa L. Ford  
Biotechnology Patent Examiner  
April 5, 2004

  
NTA MINNESOTA  
PRIMARY EXAMINER  
4/26/04